

## **REMARKS**

Applicant has carefully reviewed the Office Action mailed March 17, 2009 and offers the following remarks.

Claims 1-15 and 30-44 remain pending. Claims 16-29 and 45-58 were previously withdrawn.

Claims 1-3, 6-8, 11-15, 30-32, 35-37, and 40-44 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,373,828 B1 to Stewart et al. (hereinafter "Stewart"). Applicant respectfully traverses. For the Patent Office to prove anticipation, each and every element of the claims must be present in the reference. Furthermore, the elements of the reference must be arranged as claimed. M.P.E.P. § 2131.

Claim 1 recites a method for transitioning a call with a mobile terminal from a cellular connection to a local wireless connection, the method comprising:

- a) receiving an inter-switch handoff request from a wireless switch supporting a call to the mobile terminal over a cellular access network, the call comprising a first connection from the wireless switch to the mobile terminal and a second connection between the wireless switch and an entity;
- b) effecting establishment of an inter-switch handoff connection to the mobile terminal via a terminal adaptor, which supports local wireless communications with the mobile terminal; and
- c) providing an inter-switch handoff instruction to the wireless switch to connect the second connection and the inter-switch handoff connection to effect handoff of the call from the cellular connection to the local wireless connection.

Stewart does not teach each and every limitation of claim 1. First, Stewart does not teach transitioning a call with a mobile terminal from a cellular connection to a local wireless connection. Stewart does not disclose a local wireless connection. Stewart discloses a handover between a Generic C-based wireless communication system and a MSC-based wireless communication system. Neither of these systems is a local wireless connection. The Generic C-based system is an alternate cellular system implementation that leverages existing wireline switches (SSPs) to implement an alternate cellular connection in order to avoid having to deploy new MSC wireless switches (Stewart, col. 1, lines 45-52). Since the Generic C-based system is an alternate cellular system, and not a local wireless network, Stewart does not disclose

transitioning a call with a mobile terminal from a cellular connection to a local wireless connection. Thus, Stewart does not teach “effecting establishment of an inter-switch handoff connection to the mobile terminal via a terminal adaptor, which supports **local wireless communications with the mobile terminal**” and does not teach “providing an inter-switch handoff instruction to the wireless switch to connect the second connection and the inter-switch handoff connection **to effect handoff of the call from the cellular connection to the local wireless connection**,” as recited in claim 1.

In addition, Stewart does not disclose a “terminal adaptor which supports local wireless communications with the mobile terminal,” as recited in claim 1. As discussed above, Stewart does not disclose local wireless communications. Further, Stewart does not disclose the claimed terminal adaptor. The Patent Office equates element 306 of Stewart as the claimed terminal adaptor (Office Action mailed March 17, 2009, p. 3). Applicant respectfully disagrees. Element 306 in Stewart is a first base station element that includes a base station controller (BSC) 313 connected to a base station transmitter/receiver (BTS) 314 (Stewart, Figure 3; and col. 4, lines 44-46). First base station element 306 is not a terminal adaptor, but rather is similar to the second base station element 308 attached to the MSC 317 in the cellular system (Stewart, Figure 3). The first base station element 306 in Stewart supports multiple users in multiple radio cells covering large geographical areas, using CDMA protocols, like a base station in a cellular network, as discussed above. The first base station element 306 does not support communications in a small local wireless area using WLAN or 802.11 protocols. Thus, the first base station element 306 does not support local wireless communications with the mobile terminal. Accordingly, the first base station element 306 cannot be the claimed “terminal adaptor, which supports **local wireless communications with the mobile terminal**.” Therefore, Stewart does not disclose “effecting establishment of an inter-switch handoff connection to the mobile terminal via a terminal adaptor, which supports **local wireless communications with the mobile terminal**” for this additional reason.

Moreover, in the invention of claim 1, the inter-switch handoff connection is established to the mobile terminal via the terminal adapter and then the handoff is effected by connecting the already established connection between the wireless switch and the entity (referred to as the “second connection” in claim 1) with the inter-switch handoff connection to the mobile terminal via the terminal adapter. Stewart does not teach this limitation. In Stewart, the MSC in the

cellular system notifies the Generic C-based system that a handoff is desired (Stewart, Figure 7, step 613). A new voice path is established between the first base station element 306 of the Generic C-based system and the MSC in the cellular system (Stewart, Figure 7, step 621). The MSC then completes the handover by dropping the portion of the radio connection between the MSC and the second base station element in the cellular system and connecting to the new voice path between the first base station element 306 of the Generic C-based system and the MSC in the cellular system (Stewart, Figure 7, step 629). Thus, Stewart never discloses an inter-switch handoff connection being established **to the mobile terminal via the terminal adaptor**, as recited in claim 1. Stewart discloses a connection being established between the first base station element 306 of the Generic C-based system and the MSC in the cellular system. In Stewart, the common connection point is at the MSC in the cellular system (there is a first connection between the MSC and the second base station element 308 in the cellular system and then a second connection between the MSC and the first base station element 306 in the Generic C-based system). Stewart does not teach an inter-switch handoff connection being established to **the mobile terminal via the terminal adaptor**, which supports local wireless communications with the mobile terminal, as recited in claim 1. Claim 1 is therefore not anticipated by Stewart for this additional reason.

Claim 30 contains similar limitations as those recited in claim 1. Claim 30 is thus patentable for at least the same reasons discussed above with respect to claim 1.

Claims 2, 3, 6-8, and 11-15 depend from claim 1; claims 31, 32, 35-37, and 40-44 depend from claim 30. Therefore, claims 2, 3, 6-8, 11-15, 31, 32, 35-37, and 40-44 are allowable for at least the same reasons as claims 1 and 30.

Claims 4, 5, 9, 10, 33, 34, 38, and 39 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Stewart in view of U.S. Patent No. 7,136,375 B1 to Koistinen (hereinafter “Koistinen”). Applicant respectfully traverses. When rejecting a claim under § 103, the Patent Office must either show that the prior art references teach or suggest all limitations of the claim or explain why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art. Examination Guidelines for Determining Obviousness Under 35 U.S.C. § 103 in View of the Supreme Court Decision in *KSR International Co. v. Teleflex Inc.*, published in the Federal Register, Vol. 72, No. 195, pages 57526-57535. The gap between the prior art and the claimed invention may not be “so great as

to render the [claim] nonobvious to one reasonably skilled in the art.” *Dann v. Johnston*, 425 U.S. 219, 230, 189 U.S.P.Q. (BNA) 257, 261 (1976). In this case, the Patent Office has failed to show where each and every limitation of the claims is taught or suggested by the prior art. Further, for those limitations of the claims that are not taught or suggested by the prior art, the Patent Office has failed to explain why those limitations would have been obvious to one of ordinary skill in the art.

Claims 4, 5, 9, and 10 depend from claim 1, and claims 33, 34, 38, and 39 depend from claim 30. As discussed above, Stewart does not teach or suggest each and every limitation of claims 1 and 30. Koistinen does not cure the deficiencies of Stewart in this regard. Therefore, the Patent Office has failed to establish *prima facie* obviousness of claims 4, 5, 9, 10, 33, 34, 38, and 39 based on the combination of Koistinen and Stewart. Accordingly, claims 4, 5, 9, 10, 33, 34, 38, and 39 are allowable for at least the same reasons as claims 1 and 30.

The present application is now in condition for allowance and such action is respectfully requested. The Examiner is encouraged to contact Applicant’s representative regarding any remaining issues in an effort to expedite allowance and issuance of the present application.

Respectfully submitted,

WITHROW & TERRANOVA, P.L.L.C.

By:



John R. Witcher, III  
Registration No. 39,877  
100 Regency Forest Drive, Suite 160  
Cary, NC 27518  
Telephone: (919) 238-2300

Date: July 16, 2009  
Attorney Docket: 7000-272